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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,137	08/01/2003	James T. Curry	67323-011	1821

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MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
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2153

MAIL DATE	DELIVERY MODE
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06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,137

Applicant(s)

CURRY ET AL.

Examiner

Krisna Lim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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1. Claims 1-30 are presented for examination.
2. The title of the invention is neither descriptive nor precise. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. The title should reflect the gist of or the improvement of the present invention.

3. Claims 24-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what the applicant really means by "executable code transportable by at least one machine readable medium". Applicant is recommended to amend the language to make sure that the code is computer executed and stored in a machine readable medium.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

5. Claims 24-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as being an intangible media (e.g., a program product) and an abstract idea. A program product is not tangibly embodied in a manner so as to be executable. Applicant is recommended to amend the claimed language to make sure that the executable code is stored in a machine readable medium.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-30 are rejected under 35 U.S.C. §102(e) as being anticipated by Raghunandan [U.S. Patent No. 6,816,885].

8. Raghunandan anticipates (e.g., see Figs. 1-4) the invention substantially as claimed. Taking claim 1 as an exemplary claim, the reference anticipates a method for formatting electronic mail sent from an e-mail client and received by a gateway server for receiving and processing inbound e-mail or a gateway server for receiving and processing outbound e-mail, comprising the steps of:

a) receiving an e-mail message from the e-mail composer; text-parsing the received e-mail for identifying the e-mail attribute (10 of Fig. 2, the abstract, col. 4 (line 30), col. 10 (lines 17-18));

b) text-parsing the received e-mail for identifying the e-mail attribute (11 and 13 of Fig. 2, the abstract, col. 4 (lines 306-38) col. 10 (lines 17-20));

c) formatting the received e-mail message in accordance with predetermined formats (pre-determined classification, col. 4, line 32) corresponding to the identified the e-mail attribute (e.g., see col. 4 (lines 36-41), col. 10 (lines 17-38)); and

d) sending the formatted e-mail message to intended recipient(s) (e.g., see col. 16 of Fig. 2 and the abstract)

9. As to claim 2, Raghunandan the step of identifying the e-mail attribute comprises the step of identifying the e-mail attribute from a header of the received e-mail (e.g., see 11 of Fig. 2, col. 4 (lines 36-41), col. 10 (lines 17-38)).

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10. As to claim 3, Raghunandan anticipates the e-mail attribute includes any one of sender, recipient information in the header (e.g., see 11 of Fig. 2, col. 4 (lines 36-41), col. 10 (lines 17-38)).

11. As to claim 4, Raghunandan anticipates the step of identifying the e-mail attribute comprises the step of identifying e-mail attribute from a body of the received e-mail (e.g., see 13 of Fig. 2, col. 4 (lines 36-41), col. 10 (lines 17-38)).

12. As to claim 5, Raghunandan anticipates the e-mail attribute includes a predetermined keyword in the body of the e-mail (e.g., see 13 of Fig. 2, col. 4 (lines 36-41), col. 10 (lines 17-18)).

13. As to claim 6, Raghunandan anticipates the step of associating a predetermined format (predetermined classification) in accordance with an identified e-mail attribute (e.g., see 11 of Fig. 2, col. 4 (lines 36-41), col. 10 (lines 17-38)).

14. As to claim 7, Raghunandan anticipates the predetermined formats (predetermined classification) include any combination of a plurality of templates (e.g., see 15-21 of Fig. 2, col. 4 (line 49), col. 10 (lines 5-6, 17-38)).

15. As to claim 8, Raghunandan anticipates the plurality of templates (e.g., see 15-21 of Fig. 2, col. 4 (line 49), col. 10 (lines 5-6, 17-38)) include any one of user information and digital signature.

16. As to claim 9, Raghunandan anticipates the step of associating the predetermined format includes accessing a library compiling predetermined formats and selecting the predetermined format in accordance with e-mail attribute (e.g., see 15-21 of Fig. 2, col. 4 (line 49), col. 10 (lines 5-6, 17-38)).

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17. As to claim 10, Raghunandan anticipates the steps of extracting an e-mail portion from the e-mail corresponding to any one of a new message portion, a reply portion, and a forwarded portion (e.g., see col. 9 (line 51) to col. 10 (line 47)).

18. As to claim 11, Raghunandan anticipates formatting the extracted e-mail portion according to an e-mail attribute of the extracted e-mail portion (e.g., see col. 9 (line 51) to col. 10 (line 47)).

19. As to claim 12, Raghunandan anticipates determining an e-mail client associated with the e-mail portion (e.g., see col. 9 (line 51) to col. 10 (line 47)).

20. As to claim 13, Raghunandan anticipates forcing a predetermined format by user override (predetermined classification, col. 4 (lines 36-41), col. 10 (lines 17-38)).

21. Claims 14-30 are similar in scope as of claims 1-13 with the additional feature of a server and a client station (this is inherent in a network, see col. 4, line 64), and therefore claims 14-30 are rejected for the same reasons set forth above for claims 1-13.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishna Lim whose telephone number is 571-

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272-3956 The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

May 26, 2007



KRISNA LIM
PRIMARY EXAMINER